

Remarks

Preliminary Matters

No Claims have been added; no Claims have been cancelled. No additional fees are required. If determined otherwise, the Office is authorized to charge Deposit Account No. 07-1077 for the amount.

§112 Rejection

Applicant has deleted the phrase “of at least 22 percent.” Applicant relies on the particular combination of four, and only four, nucleating agents, with support for their description, enablement, and best mode being found in Examples 10 and 11.

§ 103 Rejection

All pending claims were rejected applying the combination of Asuka, Takahashi et al., Utz et al., and the newest reference, Ogawa et al. Unexpressed in the Office Action was the reality that the amendments to the claims *did overcome* the prior rejection combining Asuka, Takahashi et al., and Utz et al.

Because Claim 8 is directed to a *method of use*, the purpose of the claimed combination of four specific nucleating agents in Claim 8 becomes patentably distinguishable over the combination of Asuka, Takahashi et al., and Utz et al, and now also Ogawa et al.

Asuka at Paragraph [0009] of the machine translation identifies the solution to the problem to be achievement of many things, but none of them reduced cycle time.

Takahashi et al. at Paragraph [0006] of the machine translation identifies the problem to be dispersability of the nucleating agent in the polyolefin resin.

Utz et al. at Paragraph [0114] identifies the reason for the use of a nucleating agent is to improve stiffness and die-cutability of the film.

Ogawa et al. mentions calcium carbonate, talc, and silica as nucleating agents. Ogawa et al. is silent about cycle time reduction.

None of the cited references teaches or suggests that one can reduce cycle time by the use of any nucleating agent, let alone the *particular* combination of four chemicals claimed in Claim 8.

The Office has added Ogawa et al. to prove that thermoplastic elastomers are suitable for injection molding. But Ogawa et al. are not concerned with reduction in cycle time. A keyword search fails to reveal any reference to “cycle” or “cycle time”.

Asuka teaches the making of film, not an article with a faster cycle time because of the use of the particular combination of nucleating agents found in Claim 8.

Takahashi et al. were making granules of nucleating agent in binder and metal soap for better dispersability of that masterbatch into polyolefin resin.

Utz et al. were making two-layer card stock with a printable top layer and a polymer bottom layer.

These four references seem unconnected to each other, let alone worthy of being combined to reject the pending claims.

The standard for examination is that a person having ordinary skill in the art (PHOSITA) would find a claimed invention obvious, reviewing both the prior art references as a whole and also the claimed invention as a whole. MPEP §2141.02 I and MPEP §2141.02 VI. When it takes the combination of four seemingly unrelated references, teaching in different directions for the reason of the presence of any nucleating agent, having no regard for *either* the reason to include four different nucleating agents into a compound for its subsequent molding or the particular combination of those four exemplified to demonstrate faster cycle time over conventional, commercial products, it seems the standard has become obviousness for a person having *extraordinary* skill in the art (PHESITA).

The ordinary molder, a customer of this inventive compounder, benefits from the claimed *method of use*, because the compounder has pre-loaded four specific nucleating

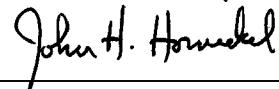
agents which work together to reduce the cycle time when the customer is using the compound to injection mold that compound into a new shape. Any molder seeing the results of Examples 10 and 11 compared with actual commercial products¹ using the same molds would be surprised by the faster cycle times². That customer has a faster cycle time of molding. In an industry where profits are slim and every penny counts, any amount of faster cycle time of molding is highly desired. Pre-loading in a compound the means by which its injection molding cycle time is shortened is an invention, a patentable invention, worthy of the reward of a patent.

There has already been one Request for Continued Examination. There is nothing more to do. Applicant is ready to appeal if no allowance is granted.

Respectfully submitted by:

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Date



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¹ If the applicant knew the composition of the Comparative Examples C3-C5, he would have provided them. In the reality of commerce, the test of Examples 10 and 11 against Comparative Examples C3-C5 is more indicative of patentability than a contrived test of Examples 10 and 11 against an aggregation of unconnected references, which to form the proper combination for comparison would require more than a bit of hindsight. Comparative marketing law would applaud the real test; it would consider the test proposed by the Office to be factually unsupportable. Which parts of the four references cited in combination should the applicant have chosen if the applicant were to have conducted experiments to prove unexpected results *relative to the prior art?* Which parts of which references? It is an impossible task to fulfill.

² The present Office Action also makes a statement that the applicant is required to provide the amount of unexpectedness, as if to establish that a small amount of unexpectedness is not enough. Please cite the law on that point.